

REMARKS

Currently claims 7 and 10 are pending in the above-identified application. By this Amendment, claims 1-4, 9, 11-12 and 14 have been cancelled. No new claims are added. In view of the above amendments and following remarks, Applicants respectfully request the reconsideration of the outstanding rejections directed to the pending claims.

I. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejects claims 1-4, 7, 9-12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,004,723 to Eda (hereinafter “Eda”) in view of Japanese Patent Application No. JP 60-191758 to Kamimura (hereinafter “Kamimura”). This rejection is respectfully traversed, and with regards to claims 1-4, 9, 11-12 and 14, rendered moot by their cancellation.

Accordingly, only claims 7 and 10 are currently pending and rejected under the asserted combination of Eda in view of Kamimura.

In view of the Decision rendered by the Board and the prosecution record, the grounds by which the Examiner rejected claim 10 over have been reversed. That is to say that pursuant to this Reply and Amendment, prosecution is respectively reopened with regards to the above-identified pending claims.

With regards to independent claim 7, Applicants respectfully assert that independent claim 7 is patentably distinct over the combination of Eda in view of Kamimura.

The Decision by the Board has offered some insight into the claim rejections of, for example, claims 7 and 10 advanced by the Examiner in charge of the instant application. However, Applicants respectfully assert that the insight contained within the Decision granted by the Board does not fully and properly interpret the combination of Eda and Kamimura.

Specifically, no assertions made by either the Board or the Examiner, correctly address the elemental combination as previously argued by the Applicants. These elemental combinations of the claimed invention, are clearly found through the Specification, as originally filed.

For the convenience of the Examiner, one exemplary illustration may be drawn from the following section.

The biasing member 30 having a curved surface of a circular arc in a section contacting an outer circumferential surface of the second bearing 17 and support section, *inter alia* including a spring supporter 31 inserted so as to be movable toward the second bearing hole 82; a spring body 32 of a coil spring supported by the spring supporter 31; a screw body 33 adjusting a flexure amount of the spring body 32 contracted in the tapped hole 84; and a lock nut 34 screwed on the screw body 33. The biasing member deflects the second bearing 17 toward the concave portion 83 by operating the screw body 33 in a state where the lock nut 34 is loose, to move the spring supported 31. See, for example, Specification, page 11, lines 10-21.

The claimed biasing member 30 deflects the second bearing 17 toward the concave portion 83 by operating the screw body 33, in a state (separate from the non-deflected state (added for emphasis)) where the lock nut 34 is loose to move the spring supporter 31. *Emphasis added.*

The claimed biasing member, as recited in claim 7, operates with a bearing, a worm shaft operating towards a worm wheel. The Examiner alleges that Kamimura's spring 48 corresponds to the claimed biasing member, and further appears to allege that in an opening Kamimura's element 42, in which bearing 43 is mounted correspond to the recited concave member. However, claim 7 recites that movement of the biasing member is *only* toward the concave member. Clearly, the claimed biasing member, deflecting the second bearing toward the concave portion 83 operates to redirect the applied forces, or in other words, prevents the applied forces from moving the second bearing 17 in a fashion, away from the concave member. Kamimura instead makes it clear that spring 48 can move both towards and away from a bearing 43, *clearly contrary to claim 7.*

Accordingly, Applicants respectfully assert that this descriptive construction more fully and properly offers an illustrative construction and accordingly, should be clearly weighed in consideration by the Examiner in charge, as he now considers his previously asserted rejection of claim 7 under the asserted combination of Eda in view of Kamimura under § 103.

II. Specific Functional and Motivational Assertions Are Absent From the Examiner's Previous Analysis

Based upon the record of prosecution, prior to the Decision by the Board, the record indicates that the Examiner had previously asserted that a mere modification was all that was necessary to arrive at the instant claimed invention, with regards to independent claim 7. That is to say that the Examiner alleged that Eda could be merely modified with Kamimura to arrive at the instant claimed invention recited by independent claim 7. Specifically, the Examiner recited "to modify the worm gear arrangement of Eda with the mechanism for setting backlash taught by Kamimura", as asserted in the Examiner's Answer prior to the Board's Decision.

However, and as supplied in the Reply Brief, the Examiner did not indicate a reason or rationale of modification for modifying Eda. Furthermore, even if Eda and Kamimura were combined, Applicants respectfully assert that such a combination does not show or suggest the invention as supported by independent claim 7.

It appears that the Examiner has offered an alternative interpretation by the combination of structure comprising Eda and Kamimura; but it appears that the combination of structure is not one that would be obviously arrived at without undue experimentation and/or further modification. As such, Applicants respectfully assert that this would impermissibly change the principle of operation of Eda's device. See, for example, MPEP 2143.01.

The threshold determination is whether or not Kamimura could be combinable with Eda in such a fashion that the operation of Eda would not be impermissibly altered. Applicants respectfully assert that this construction of Kamimura to supply a mechanism for setting backlash at taught by Kamimura, fails to arrive at the instant claimed invention, as supported by independent claim 7, without impermissible changes made to the operation of Eda.

Even with the Board's assertion that Eda's device may already address backlash, that particular backlash event is only limited to a particular structural operation which does not comport with a combination of the structure taken from Kamimura. That is to say that without the mere direction or suggestion of a structural combination/modification of Eda's device to incorporate Kamimura's device (with regards to the mechanism for setting backlash) one of

ordinary skill would have no actual explicit understanding whether the devices in combination could actually achieve the desired result without undue experimentation.

Accordingly, Applicants respectfully assert that a *prima facie* case of obviousness has not been established by the Examiner with regards to claim 7 and accordingly, claim 7 at a minimum, should be allowed.

Furthermore, and in view of the Decision provided by the Board, as well as the fact that claim 10 depends directly from independent claim 7, Applicants respectfully assert that claim 10 is similarly clearly allowable, not only for the basis by which it depends from independent claim 7, but also for the analysis provided by the Board, and any of the additional recitations contained therein.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 7 and 10 under § 103 over the combination of Eda and Kamimura.

III. Conclusion

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

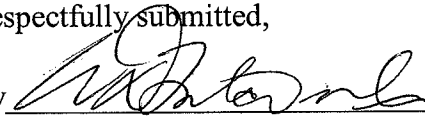
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact William D. Titcomb Reg. No. 46,463 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: February 19, 2009

Respectfully submitted,

By

 46463
Michael K. Mutter WILLIAM D. TITCOMB
Registration No.: 29,680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicants